



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/685,493

10/16/2003

Motonaga Gomi

1619.1025

5367

21171

7590

05/25/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

HUTTON JR, WILLIAM D

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/685,493	Applicant(s) GOMI ET AL.	
	Examiner Doug Hutton	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Applicant's Response***

In Applicant's Response dated 04/05/2006, Applicant amended the Specification, amended Claim 1, and argued against all objections and rejections previously set forth in the Office Action dated 01/05/2006.

### ***Specification***

The disclosure is objected to because the entire specification is replete with **idiomatic errors in the English language**. The present application claims priority to Japanese Patent Application No. 2002-305028 and appears to be a poorly-worded translation of the Japanese application.

The disclosure is also objected to because the entire specification is replete with terminology which is ***different*** from that which is generally accepted in the art to which this invention pertains and does not conform to United States patent practice.

For example, the first sentence of Paragraph 0003 reads: "If the files forming the electronic document are temporarily stored in a local area of a computer before printing, a user needs to modify the ***absolute description*** of the links in the main file to the location of the files in the storing area" (emphasis added). The phrase "absolute description" in the context of links on an HTML page is not normally used in the art of printing HTML pages. The examiner is unsure what an "absolute description" of a hyperlink is. Also, the examiner is unsure what is meant by "modifying" an absolute

description. Thus, this terminology does not conform to United States patent practice and makes the meaning of the sentence unclear.

Another example includes the first sentence of Paragraph 0004, which reads: "In order to shorten the time required to print an electronic document described in HTML, Japanese Unexamined Patent Application Publication No. 11-25156 describes a method in which a system downloads the files forming a Web page, automatically embeds the **description** of the linked file (the linked page) at the point of the link anchor of the **main file** (the main page), and prints the new edited file" (emphasis added). The examiner is unsure what the "description" of the linked file is. Also, the examiner is unsure what the "main file" is and how it differs from the "linked files." Thus, this terminology does not conform to United States patent practice and makes the meaning of the sentence unclear.

Another example includes Paragraph 0005 which reads: "It is one object of the present invention to provide a system, a method and a computer program for printing such a downloaded electronic document, for example a online help file or an online manual file, **promised** on viewing by a **Web viewer** onto **sheet material** to obtain a **real printed material having the proper style of a booklet or a book**" (emphasis added). The examiner is unsure what is meant by the phrase "promised on viewing by a Web viewer." Additionally, the paragraph is not written in idiomatic English, as demonstrated by the phrases "Web viewer" (most likely a browser), "sheet material" (most likely paper) and "real printed material having the proper style of a booklet or a book" (most likely a book or a booklet). This terminology is not idiomatic English, does

not conform to United States patent practice and makes the meaning of the paragraph unclear.

Another example includes Paragraph 0006 which reads: "Specifically, it is the object of the present invention to provide a system, a method and a computer program for printing a downloaded electronic document as a real printed material having a front cover printed ***such the title of the document, the table of contents and so on***; or a header, a footer, or both of them printed the title of a chapter printed on pages" (emphasis added). The examiner is unsure what is meant by the phrase "such the title of the document, the table of contents and so on." As currently stated, this paragraph is not idiomatic English and must be corrected.

The remainder of the Specification is replete with idiomatic errors in the English language. Thus, a substitute specification in **proper idiomatic English** and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Finally, the disclosure is objected to because the translation of the Japanese patent application is **inaccurate**. For example, text in Paragraph 0003 reads: "Further, printing an electronic document displayed by a Web viewer directly causes some problems: printing navigation icons such as a previous-page button icon, a next-page button icon, a top-page button icon, and navigation banner, which are necessary for browsing but not necessary in the printed material, ***reduces*** the density of information on printed page" (emphasis added). This statement is not accurate in that, if the navigation icons of a web page **are** printed in a hard copy printout of the web page, then

the amount of information printed on the printed page is increased and therefore the “density of information” in the printed page is **increased**. This is but one example of the multitude of errors made in translating the Japanese patent application.

To obviate this objection, Applicant should go through the **entire** Specification – word-by-word, sentence-by-sentence, paragraph-by-paragraph – and rewrite the entire specification so that it: 1) reads easily for, and is easily understood by, a person whose native language is English; 2) consistently uses terminology – **used in the United States** – that is generally accepted in the art; 3) conforms to United States patent practice; and 4) accurately describes Applicant’s invention.

Additionally, the disclosure is objected to because the entire specification is replete with instances where a **single** element of the present invention is identified using a **plurality** of terms, whereby such use makes it unclear as to which element is being discussed in that portion of the text. For example, it appears that the “HTML file” in Paragraph 0002 is called a “main file” in Paragraph 0003.

To obviate this objection, Applicant must amend the Specification so that the terms used to identify the elements of the present invention are used in a **consistent** manner.

### ***Claim Objections***

Claims 1-7 are objected to because of the following informalities:

- In Claim 1, the phrase “**analysis defining information storing means for**” in Line 3 should be amended to — means for — because the phrase “*analysis defining information storing*” is subsequently recited and therefore unnecessary.
- In Claim 1, the phrase “**cover file generating means for**” in Line 6 should be amended to — means for — because the phrase “*cover file generating*” obscures the “*means for*” language in the limitation and is unnecessary.
- In Claim 1, the phrase “**file analyzing and converting means for**” in Line 9 should be amended to — means for — because the “*file analyzing*” and the “*converting*” functions are subsequently recited and therefore it is unnecessary to recite the functions before the “*means for*” language.
- In Claim 1, the phrase “**printing processing means for**” in Line 15 should be amended to — means for — because the “*printing*” function is subsequently recited and therefore it is unnecessary to recite the function before the “*means for*” language.
- Claims 2-7 also have the same type of problems discussed above.
- In Claim 1, the term “*on*” in Line 8 should be amended to — in — because it appears to be a typographic error.
- In Claim 1, the phrase “*described in the document file*” in Lines 7-8 should be amended because no “*document file*” is previously mentioned in the claims.
- In Claim 1, the phrase “*analyzing the description of the document file*” in Line 9 should be amended because no “*description of the document file*” is previously mentioned in the claims.

Appropriate correction is required.

Claims 1-16 are objected to because the claims comprise idiomatic errors in the English language and because the claims are worded confusingly. For example, in Claim 2, the phrase "*for obtaining a document files in the markup language generating one electronic document*" in Lines 2-3. This phrase is grammatically incorrect and is worded confusingly. If a person whose native language is English reads this phrase, then that person would immediately recognize that the phrase comprises idiomatic errors and is worded confusingly.

Such problems are replete throughout the claims of the present application. Any reader whose native language is English will recognize these problems. Thus, the claims must be amended to eliminate the grammatical errors and the confusing portions. For example, the previously-discussed phrase of Claim 2 should be amended to — for obtaining ~~[[a]]~~ markup language ~~document files in the markup language~~ that make up the electronic document and generating one ~~the~~ electronic document —

To obviate these objections, Applicant should go through the each claim – word-by-word, element-by-element, section-by-section – and rewrite the each claim so that every claim reads easily for, and is easily understood by, a person whose native language is English.



***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claims 1-16:***

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, in Claim 1, the passage "*file analyzing and converting means for analyzing the description of the document file based on the analysis defining information, for deleting information unnecessary for printing of the document from the document file, for analyzing a document structure of the electronic document, for dividing the document file on item unit generating the document structure in accordance with the analyzed document structure, and for generating a converted files; and*" (see Lines 10-15) has several problems that lead to questions concerning the passage.

These questions include: 1) Does the phrase "*analyzing the **description** of the document file*" mentioned in the passage involve the markup language document mentioned in Line 1? 2) What does "*dividing the document file **on item unit generating the document structure in accordance with the analyzed document structure***" (Lines 13-15) mean?

Generally speaking, Claim 1 needs to be amended so that the subject matter recited in the claim is better organized and more clearly recited. In order to do this, Applicant should determine **what** the software **does**, (i.e., the functions performed by the software), determine the **relationships** of the software functions, and recite the functions performed by the software in a way that **comprehensively defines the invention using idiomatic English**.

As indicated in the above discussion, the entire disclosure (i.e., the Specification and the Claims) of the present invention is very poorly-worded. Thus, at this time, the examiner deems it impractical to give a complete action on the merits for this application. Once the claims are amended to particularly point out and distinctly claim the subject matter which Applicant regards as his invention, a full search and examination will be performed.

In Claim 1, the limitation "*analysis defining information storing means for storing analysis defining information for analysis **which is determined based on a description rule and a template** used for describing the electronic document in the markup language*" in Lines 3-5 is indefinite because it is unclear **what** is "*determined based on a description rule and a template.*" Stated differently, it is unclear whether it is the "*storing means,*" the "*information*" or the "*analysis*" that is "*determined based on a description rule and a template.*" This problem appears to stem from the translation of the Japanese application. As previously indicated, the translation is not written in idiomatic English.

This limitation is indefinite also because the meaning of the phrase "*description rule*" (see Line 4) cannot be determined. As indicated in the above discussion, some element of the present invention is "*determined based on a description rule.*" However, the Specification provides no indication of or guidance in determining the meaning of the term "*description rule.*"

The substitute Specification submitted by Applicant in the Response dated 04/05/2006 recites the phrase "*description rule*" four times:

- Page 13, Paragraph 0008, first sentence → here, this use of the phrase restates Claim 1, Lines 3-4;
- Page 13, Paragraph 0009, second sentence → here, this use of the phrase essentially restates Claim 1, Lines 3-4;
- Page 16, Paragraph 0019, first sentence → here, this use of the phrase states that the description rule is "used upon describing the electronic document in HTML;" and
- Page 29, Paragraph 0067, second sentence → here, this use of the phrase states that the description rule "previously determines" information that is "used in the case of describing [sic] in the markup language."

None of these uses provide guidance in determining the meaning of the phrase "*description rule.*" The examiner cannot locate any other uses of the phrase "*description rule*" in the Specification. Thus, because the meaning of the phrase "*description rule*" cannot be determined, the scope of the present invention cannot be determined, thereby making Claim 1 indefinite.

Finally, this limitation is indefinite also because it is unclear whether an element of the present invention is “*based on a description rule*” **only** or is “*based on **[both]** a description rule and a template*” (see Lines 3-5).

In Claim 1, the limitation “*cover file generating means for extracting cover information displayed on a cover of the electronic document **based on tag information on a tag and a directive** described in the document file and for generating a cover file of the electronic document*” in Lines 6-8 is indefinite because it is unclear **what** is “*based on tag information on a tag and a directive.*” Stated differently, it is unclear whether it is the “*generating means,*” the “*cover information*” or the “*electronic document*” that is “*based on tag information on a tag and a directive.*” This problem appears to stem from the translation of the Japanese application. As previously indicated, the translation is not written in idiomatic English.

This limitation is also indefinite because it is unclear whether Applicant intends to invoke 35 U.S.C. 112, sixth paragraph, for the phrase “*for generating a cover file of the electronic document*” in Line 8. Thus, the scope of the present invention cannot be determined, thereby making Claim 1 indefinite.

Finally, this limitation is indefinite also because it is unclear whether an element of the present invention is “*based on tag information on a tag*” **only** or is “*based on **[both]** tag information on a tag and a directive*” (see Lines 6-8).

In Claim 1, the limitation "*file analyzing and converting means for analyzing the description of the document file **based on the analysis defining information**, for deleting information unnecessary for printing of the document from the document file, for analyzing a document structure of the electronic document, for dividing the document file into item units and generating the document structure in accordance with the analyzed document structure, and for generating a converted file*" in Lines 9-14 is indefinite because it is unclear what is "*based on the analysis defining information.*" Stated differently, it is unclear whether it is the "*file analyzing and converting means,*" the "*analyzation,*" the "*description*" or the "*document file*" that is "*based on the analysis defining information.*" This problem appears to stem from the translation of the Japanese application. As previously indicated, the translation is not written in idiomatic English.

This limitation is also indefinite because it is unclear whether Applicant intends to invoke 35 U.S.C. 112, sixth paragraph, for the phrases "*for deleting information unnecessary for printing of the document from the document file*" in Lines 10-11, "*for analyzing a document structure of the electronic document*" in Lines 11-12, "*for dividing the document file into item units*" in Line 12, "*for . . . generating the document structure in accordance with the analyzed document structure*" in Lines 12-13 and "*for generating a converted file*" in Lines 13-14. Thus, the scope of the present invention cannot be determined, thereby making Claim 1 indefinite.

In Claim 1, the limitation "*printing processing means for printing a document with the cover based on the cover file and the converted file in accordance with a request for printing the electronic document*" in Lines 15-16 is indefinite because it is unclear what is "*based on the cover file and the converted file.*" Stated differently, it is unclear whether it is the "*printing processing means,*" the "*printing,*" the "*document*" or the "*cover*" that is "*based on the cover file and the converted file.*" This problem appears to stem from the translation of the Japanese application. As previously indicated, the translation is not written in idiomatic English.

Claims 2-7 are dependent upon Claim 1 and are thus rejected for the same reasons indicated in the above discussion.

Claims 8, 15 and 16 essentially comprise the same limitations as Claim 1. Thus, Claims 8, 15 and 16 are rejected for the same reasons indicated in the above discussion.

Claims 9-14 are dependent upon Claim 8 and are thus rejected for the same reasons indicated in the above discussion.

### ***Response to Arguments***

Applicant's arguments filed 04/05/2006 have been fully considered but they are not persuasive.

#### ***Objections to the Specification:***

In response to the examiner's assertion that the terminology used in the Specification is different from that which is generally accepted in the art, Applicant points out that an applicant may be his own lexicographer. Applicant then notes that new concepts require new words. See *Response* – Pages 9-10, spanning paragraph.

The examiner disagrees.

Applicant is correct in that he may be his own lexicographer. However, the Specification provides no guidance in defining the terms that are different from that which is generally accepted in the art. For example, the Specification often refers to a "description" of an HTML file. However, the Specification fails to adequately describe this "description" of an HTML file in a way that defines the meaning of the term.

The examiner disagrees with Applicant's assertion that new concepts require new words. In the examiner's experience, the vast majority of patent applications in the area of processing electronic documents use "old" terminology to describe "new" concepts. That is, a **new** way of processing an electronic document can be described using terminology that is **commonly-used** and **well-known** in the art. Thus, new words are not required, nor are they normally used, to describe new concepts.

This problem very likely stems from the translation of the Japanese application. Either Applicant did not have a native English speaker review and edit the application before submitting it to the USPTO, or the native English-speaking reviewer failed to edit the application in a competent manner.

The examiner suggests that, in the future, Applicant have a native English-speaking person review and edit the translated application before submitting it to the USPTO.

Applicant argues that printing navigation buttons will reduce the density of information on the printed page because the buttons are not information, but rather are extraneous to the information. Thus, Applicant argues, printing the buttons should reduce the density of information printed on the page since more items on the page will be non-information. See *Response* – Page 10, first full paragraph.

The examiner disagrees.

Applicant's reasoning is illogical. The page may be printed either **with** or **without** the buttons. If the buttons are **not** printed on the page, then there is **less** printed matter on the page. Conversely, if the buttons **are** printed on the page, then there is **more** printed matter on the page. **More** printed matter on the page results in an **increase** in the density of information on the printed page. To argue otherwise is illogical.



In response to the examiner's assertion that Applicant must use terms in a consistent manner, Applicant argues that using synonyms is often used in the interest of full disclosure and that such is consistent with application drafting standards. See *Response* – Page 10, second full paragraph.

The examiner disagrees.

Using synonyms to describe a single element in a patent application is acceptable when use of the synonyms does not make the disclosure unclear. However, in the present application, using different terms to describe the same element of the present invention makes the disclosure confusing and difficult to read. Again, this problem very likely stems from the translation of the Japanese application.

*Objections to the Claims:*

Applicant requested some support for the examiner's assertion that the claims must read easily for, and be understood easily by, a person whose native language is English, because 35 U.S.C. 112 requires only that claims must only be written "in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." See *Response* – Page 10, fifth full paragraph.

The examiner disagrees.

The objections were not set forth based on 35 U.S.C. 112. Therefore, Applicant argument is not relevant. However, the examiner will comment that English is the required language for patent application submitted to the USPTO – see 37 C.F.R.

1.52(b)(1)(ii). Additionally, MPEP 608.01 states that if an English translation of a foreign application does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. Such an amendment is needed in the present application.

*Claim Rejections – 35 U.S.C. § 112:*

Applicant comments that Claim 1 was amended to make the claim more definite but does not submit arguments against the rejections. Thus, the examiner has no response.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2176

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH  
May 16, 2006



**DOUG HUTTON  
PRIMARY EXAMINER  
TECH CENTER 2100**